



UNITED STATES PATENT AND TRADEMARK OFFICE

101

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
-----------------	-------------	----------------------	---------------------	------------------

09/804,480	03/12/2001	Michael P. Maher	AUROBIO.026DVI	1223
------------	------------	------------------	----------------	------

20995 7590 12/23/2004

KNOBBE MARTENS OLSON & BEAR LLP
2040 MAIN STREET
FOURTEENTH FLOOR
IRVINE, CA 92614

EXAMINER

MURPHY, JOSEPH F

ART UNIT	PAPER NUMBER
----------	--------------

1646

DATE MAILED: 12/23/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No. 09/804,480	Applicant(s) MAHER ET AL.	
Examiner Joseph F Murphy	Art Unit 1646	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 04 October 2004.
- 2a) This action is **FINAL**.
- 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-8 is/are pending in the application.
 - 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 1-8 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 - a) All b) Some * c) None of:
 - 1. Certified copies of the priority documents have been received.
 - 2. Certified copies of the priority documents have been received in Application No. _____.
 - 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) Notice of References Cited (PTO-892)
- 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 09102004, 10152004.
- 4) Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) Notice of Informal Patent Application (PTO-152)
- 6) Other: _____.

Art Unit: 1646

DETAILED ACTION

Formal Matters

Claims 1-8 are pending and under consideration.

Response to Arguments

The rejection of claims 1-8 under 35 U.S.C. 102(b) as being anticipated by Sinha et al. (1995), has been withdrawn.

The rejection of claims 1-8 under 35 U.S.C. 103(a) as being unpatentable over WO 96/41166 (Tsien et al.), has been withdrawn.

New issues are set forth below.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Art Unit: 1646

Claims 1-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gonzalez et al. (1999), in view of Mitchell et al. (1992).

The claims are drawn to methods of characterizing the activity of compounds by addition of the compounds to wells containing cells, applying a biphasic electric field to vary the T_m of the cells, and monitoring the change in the T_m by means of a FRET based voltage sensor. The claims are not patentable because Gonzalez teaches a high-throughput screening method wherein cells are added to a microtiter plate, and electrical stimulation can be used for rapid and repetitive stimulation in the microtiter plates, using electrode array technology to apply the stimulus (page 437, first column first full paragraph). The Gonzalez reference further teaches that the method can be used to measure the effects of compounds on state dependent blockers of K^+ or Na^+ channels. The Gonzalez reference does not teach the stimulus protocol. However, the Mitchell reference teaches a method of measuring the response of cardiac cells in a well to electric field stimulation. In the method of Mitchell, cells are added to a well that comprises electrodes mounted on a circular insert. The Mitchell reference further teaches that the electrodes are 1 cm apart and produce a uniform electric field (page 53, column 1, second full paragraph), thus meeting the limitation of the instant claims wherein the electric field exhibits less than about 25%, 15 %, or 5% spatial variation. The Mitchell reference further teaches the use of a rectangular waveform (identical to the square waveform of instant claim 8), which meets the limitations for a biphasic electric field. Thus it would have been obvious to one of skill in the art at the time the invention was made to practice a method of characterizing the activity of compounds by addition of the compounds to wells containing cells by monitoring the change in the T_m by means of a FRET based voltage sensor, as taught by the Gonzalez reference, using a

Art Unit: 1646

square wave electric field stimulus which does not vary in space, as taught by the Mitchell reference. The motivation is provided in the Gonzalez reference which teaches that techniques for rapid stimulation of cellular membrane potential in microtiter plates would further bridge the gap between patch clamping results and optical assays while maintaining high-throughput screening compatibility (Gonzalez, page 437, first column, first full paragraph).

Conclusion

No claim is allowed.

Advisory Information

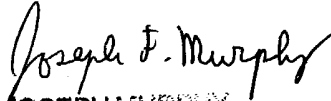
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Joseph Murphy whose telephone number is (571) 272-0877. The examiner can normally be reached Monday through Friday from 7:30 am to 5:00 pm. A message may be left on the examiner's voice mail service. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Brenda Brumback can be reached on (571) 272-0961.

The fax number for the organization where this application or proceeding is assigned is 703-872-9306.

Art Unit: 1646

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Joseph F. Murphy, Ph. D.
Patent Examiner
Art Unit 1646
December 20, 2004


JOSEPH MURPHY
PATENT EXAMINER